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09/609,596	06/30/2000	Paul Lapstun	NPA052US	1721

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EXAMINER

TRUONG, THANHNGA B

ART UNIT

PAPER NUMBER

2135

6

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PPG

Office Action Summary	Application No.	Applicant(s)
	09/609,596 Examiner Thanhnga Truong	LAPSTUN ET AL. Art Unit 2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Referring to claims 1, 7, 9, 11, 17, 18:

(1) These claims recite the limitation: "a passive laminar physical substrate (currently amended claims of pages 4-7). These limitations are new matter.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Montlick (US 5,561,446).

a. Referring to claim 1:

i. Montlick teaches:

(1) providing a printed registration form including registration information and coded data thereon, the coded data including an indication of an identity of the form and at least one reference point on the form [i.e., the central computer system is provided with software for accessing a plurality of digitally stored forms, that is for "a printed registration form", and transmitting those forms to the pen-based computers in response to selection requests, that is for "at least one reference point on the form", from the pen-based computers (column 2, lines 63-67)];

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(2) receiving in the computer system, through said terminal, indicating data from a sensing device, the indicating data including information regarding an identity of the sensing device, the identity of the form and at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data [i.e., a selected form is displayed on the screen of the pen-based computer which requests it and data is entered through the pen-based computer, that is for "indicating data from a sensing device", by handwriting on the position sensitive display which displays the form. The central computer system receives the data, that is for "including information regarding an identity of the sensing device, the identity of the form and at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data", as electronic ink and associates the electronic ink file with the form which was displayed when the electronic ink file was created (column 2, line 67 through column 3, lines 1-6)];

(3) determining, from the indicating data and stored user registration data in the computer system, an identity of a registered user of the computer system; and storing, in the computer system, registration data associating the identity of the registered user with said computer system terminal [i.e., the form and its associated electronic ink file are stored in the central computer system or in a storage device to which the central computer system has access. The handwritten data entered through the pen-based computer is thus associated with other data which can be recalled and/or associated with yet other data without the need to recognize the handwritten data as text (column 3, lines 7-13)].

b. Referring to claim 2:

i. Montlick further teaches:

(1) wherein the at least one action of the sensing device in relation to the registration form includes the formation of handwritten text and/or markings on the form [i.e., the user of the pen-based computer chooses a form by selecting it from a menu with the stylus whereupon the form is displayed on the position sensitive display of the pen-based computer. The forms typically consist

of lists of items each having a check box which may be checked, that is for “markings on the form”, with the stylus and/or spaces in which information may be written, that is for “handwritten text”, and/or drawings provided using the stylus as a writing instrument (column 3, lines 31-39)].

c. Referring to claim 3:

i. Montlick further teaches:

(1) wherein the indicating data regarding the formation of handwritten text and/or markings on the registration form is used to derive the identity of the registered user from the stored user registration data [i.e., by associating electronic ink files with digitally stored forms, the data entered through the pen-based computers is given meaning, that is for “deriving the identity of the registered user from the stored user registration data”, and the ability to be recalled and associated with other information by the central computer system (column 3, lines 52-55)].

d. Referring to claim 4:

i. Montlick further teaches:

(1) including the step of using the indicating data regarding the formation of handwritten text and/or markings on the registration form to generate from the stored user registration data, a list form indicating registered users corresponding to the indicating data, the list form having coded data including an indication of an identity of the list form and at least one reference point on the list form [i.e., the central computer system supplies the pen-based computers with a selection of standard medical forms such as patient history or physical forms. Physicians and nurses can access forms for a particular patient by selecting the name of the patient from a menu provided to the pen-based computers by the central computer system (column 3, lines 65-67 through column 4, lines 1-3)].

e. Referring to claim 5:

i. Montlick further teaches:

(1) including the step of receiving in the computer system further indicating data from the sensing device, the further indicating data including

information regarding the identity of the list form and at least one action of the sensing device in relation to the list form generated by the sensing device using at least some of the coded data, the further indicating data being used to determine one of the listed registered users for association with said computer system terminal [*i.e., the forms for the selected patient will be displayed on the pen-based computer and information may be entered on the form with the stylus. Similarly, forms which already contain information on the selected patient may be recalled and viewed by the physician or nurse using the pen-based computer (column 4, lines 4-9)*].

f. Referring to claim 6:

i. Montlick further teaches:

(1) wherein the computer system includes stored data indicating correspondence between the sensing device and a registered user, and the step of determining the identity of a registered user is performed using the stored correspondence data [*i.e., the pen-based computer therefore provides both read and write access to patient forms and forms may be write protected and/or read protected using passwords and/or other known techniques. In addition to accessing patient record forms, the central computer system may be coupled to other information storage devices such as CD-ROMs and provide the pen-based computers with a large library of information such as the Physician's Desk Reference, the Merck Manual, and the like (column 4, lines 9-17)*].

g. Referring to claim 7:

i. Montlick further teaches:

(1) providing a first printed form including registration information and coded data thereon, the coded data including an indication of an identity of the form and at least one reference point on the form [*i.e., the central computer system is provided with software for accessing a plurality of digitally stored forms, that is for "a printed registration form", and transmitting those forms to the pen-based computers in response to selection requests, that is for "at least one reference point on the form", from the pen-based computers (column 2, lines 63-67). Turning now to FIGS. 3 and 3a, certain forms displayed*

on the display 12a provide spaces within which data may be handwritten. For example, when Physical is selected from the menu 32, the interface 30 displays a page 50 representing the first page of a typical internist's patient physical form (column 8 lines 10-14)];

(2) receiving in the computer system indicating data from the sensing device, the indicating data including information regarding an identity of the sensing device, the identity of the form and at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data [i.e., a selected form is displayed on the screen of the pen-based computer which requests it and data is entered through the pen-based computer, that is for "indicating data from a sensing device", by handwriting on the position sensitive display which displays the form. The central computer system receives the data, that is for "including information regarding an identity of the sensing device, the identity of the form and at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data", as electronic ink and associates the electronic ink file with the form which was displayed when the electronic ink file was created (column 2, line 67 through column 3, lines 1-6)];

(3) identifying a registered user of the computer system from the stored correspondence between the registered user and the received identity of the sensing device [i.e., According to the interface 30 shown in FIG. 2, a patient may be selected by touching, that is for "received identity of the sensing device", the Patient icon in the functions field 34 with the stylus 12b, after which an alphabetical patient listing will be displayed in field 40 and a virtual keyboard will be displayed in field 36. By touching the first two letters of the patient's surname on the virtual keyboard with the stylus 12b, field 40 will list patients whose surname begins with those letters. Touching the Previous or Next icon in the functions field 34 with the stylus 12b will scroll the listing in field 40. It will be appreciated that this type of "multiple choice" data entry discussed thus far is digital by nature, is readily recognizable, that is for "identifying a registered user

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of the computer system from the stored correspondence", by the central computer system, and is easily stored and associated with a particular patient's records (column 7, lines 50-63)]; and

(4) generating said registration form, wherein the registration information includes an indication of the identity of the registered user [i.e., the invention provides for handwritten input of unique information which is not selected from a menu listing. The information is transmitted automatically to the central computer system via the wireless network (column 7, lines 63-67 through column 8, line 1). In addition, as shown in Figures 3 and 3a, the electronic ink file 54 is digitally associated with a reference code 56 to create an identifiable digital document 58. The reference code 56 is selected such that the electronic ink file 54 is associated with a particular form (H&P page 50) and a particular patient (John Q. Public, ID#123456789). The reference code 56 may be digitally associated with the electronic ink file 54 in the form of a file name, in the form of a file header, or a combination of file name and file header. In any case, an identifiable digital document 58 is created (column 8, lines 38-44)].

h. Referring to claim 8:

i. Montlick further teaches:

(1) including receiving in the computer system authorizing data from a second sensing device, the authorizing data including information regarding the identity of the second sensing device, the identity of the registration form and at least one action of the second sensing device in relation to the registration form generated by the second sensing device using at least some of the coded data, the second sensing device being associated in the computer system with a second registered user authorized to permit registrations of users for computer system terminals [i.e., referring now to Figure. 1, the system of the invention is preferably implemented in a system which includes a central computer system 10, that is for "receiving in the computer system authorizing data", and a plurality of portable pen-based computers 12, 14, 16, that is for "data from a second sensing device". The central computer system 10 is preferably a DOS-based INTEL processor

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having access to memory 18 containing a plurality of digitally stored medical forms 18a, 18b, 18c, 18d, . . . etc. These forms may be stored as formatted text or as image files or in any other manner consistent with industry standards (column 4, lines 57-66)].

i. Referring to claim 9:

i. Montlick further teaches:

(1) wherein the computer system terminal includes a printer, and wherein the registration form is printed, using the printer of the computer system terminal, on demand on the surface of a sheet material including printing said coded data thereon [i.e., as shown in Figure 1, a central computer system 10 may also be advantageously coupled to a modem 11 for communicating with other networks, that is “including a printer”, and/or for transmission and reception of FAX information, that is for “the registration form is printed” (column 5, lines 6-9)].

j. Referring to claim 10:

i. Montlick further teaches:

(1) including printing the coded data to be at least substantially invisible in the visible spectrum [i.e., as shown in Figure 7, printed patient record is coded for digital document. Even though the information (the handwritten notes) contained in the document is unintelligible (where “substantially invisible” is considered unintelligible), to the computer, the information can be retrieved and displayed in the context which gives it meaning to a user (column 8, lines 45-48)].

k. Referring to claim 11:

i. This claim has limitations that is similar to those of claim 1, thus it is rejected with the same rationale applied against claim 1 above.

l. Referring to claim 12:

i. This claim has limitations that is similar to those of claim 2, thus it is rejected with the same rationale applied against claim 2 above.

m. Referring to claim 13:

i. This claim has limitations that is similar to those of claim 3, thus it is rejected with the same rationale applied against claim 3 above.

n Referring to claim 14:

i. This claim has limitations that is similar to those of claim 4, thus it is rejected with the same rationale applied against claim 4 above.

o. Referring to claim 15:

i. Montlick further teaches:

(1) including the sensing device which includes an identification means that imparts a unique identity to the sensing device [i.e., **The pen-based computers are preferably ULTRALITE VERSAs from NEC and are each provided with a PCMCIA card, that is for “including an identification means that imparts a unique identity to the sensing device”, from Proxim, Inc. which gives them access to a wireless local area network (column 3, lines 19-22)**].

p. Referring to claim 16:

i. Montlick further teaches:

(1) wherein the sensing device is uniquely associated with the registered user [i.e., **the pen-based computers run software created with the PENRIGHT development system available from AST Research. This provides the pen-based computers with the ability to interact with the user in the ways described herein. The user of the pen-based computer chooses a form by selecting it from a menu with the stylus whereupon the form is displayed on the position sensitive display of the pen-based computer (column 3, lines 26-35)**].

q. Referring to claims 17 and 18:

i. These claims have limitations that is similar to those of claim 9, thus they are rejected with the same rationale applied against claim 9 above.

r. Referring to claim 19:

i. This claim has limitations that is similar to those of claim 10, thus it is rejected with the same rationale applied against claim 10 above.

Response to Arguments

4. Applicant's arguments filed March 8, 2004 have been fully considered but they are not persuasive. The applicant equates the claimed language "passive laminar physical substrate" as "ordinary paper" shown in the specification on page 10, lines 23-28. In addition, the specification does not clearly disclose or give a precise definition of what "a passive laminar physical substrate" is, as set forth in claims 1, 7, 9, 11, 17, and 18. Therefore, the examiner does not consider the applicant's arguments since the amended limitations are construed as a new subject matter.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 703-305-0327.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax and phone numbers for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

TBT

May 18, 2004



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100